

REMARKS

Applicants thank the Examiner for total consideration given the present application. Claims 1-40 remains pending. Claims 1, 3-10, 12-16, 18, and 19 have been amended through this Reply. Claims 1, 10, 16, 20, and 29 are independent. Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks.

STATEMENT OF INTERVIEW

Applicants thank the Examiner for a personal interview conducted on August 13, 2007. During the interview, the Examiner maintained that McIntyre anticipates all claimed features in claims 1, 20, and 29. The Examiner further reasoned that print-order acceptor information may be broadly interpreted as customer information included in McIntyre's ID. McIntyre's ID, which contains customer information, is scanned when the print order is requested. The Examiner agreed that the further defining "*print-order acceptor formation*" as "*print command to be sent to a receiver*" may overcome prior art rejection.

ALLOWABLE SUBJECT MATTER

Applicant appreciates that claims 3-6, 12, 18, 21-24, and 30-32 are indicated to define allowable subject matter.

35 U.S.C. § 112, 2ND PARAGRAPH REJECTION

Claims 9 and 15 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

Initially, Applicant disagrees with the Examiner's assertion that the term "renewable" renders the claims indefinite. Applicant respectfully submits that the Examiner's focus during examination for compliance with the requirement of definiteness in § 112, 2nd paragraph is whether the claim meets the threshold requirements of clarity and precision. To do this, the

Examiner needs only ensure that the claims define the invention with a reasonable degree of particularity and distinctness. See MPEP § 2173.02.

Applicant submits that the claims clearly define that the “designated print-order acceptor information are *renewable*”. The Examiner alleges that since the recording medium is a CD-R, re-recording limitation is impossible. The Applicant would like to point out that the Claims 9 and 15 recite that the print-order acceptor information is “*renewable*”. Claims 9 and 15 do not include re-recoding of the print-order acceptor information onto a same CD-R.

Therefore, Applicant respectfully requests that the Section 112, second paragraph rejection of claims 9 and 15 be withdrawn.

35 U.S.C. § 102 REJECTION – MCINTYRE ET AL.

Claims 1, 2, 7-9, 20, 25, and 29 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by McIntyre et al. (USPN 7,016,868) (hereinafter “McIntyre”). Applicant respectfully traverses this rejection. For a Section 102 rejection to be proper, the cited reference must teach or suggest each and every claimed element. *See M.P.E.P. 2131; M.P.E.P. 706.02.* Thus, if the cited reference fails to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, McIntyre fails to teach or suggest each and every claimed element. For example, independent claim 1 recites, *inter alia*, “An image print order system using a network, comprising ... *print-order acceptor information which designates an acceptor as a print-order destination ... said order receiving server outputs print command data based on the receive digital image data, and outputs command data so that a requester of a print order receives an image print that is printed based on said print command data, at a place that is determined based on the print-order acceptor information.*” *Emphasis added.*

However, McIntyre merely teaches an image print order system where it includes an ID to provide an identification of an image retaining device such as a film cartridge. The ID may also include user or customer information. However, McIntyre fails to teach or suggest “*print-*

order acceptor information which designates an acceptor as a print-order destination,” as recited in claim 1. Therefore, McIntyre fails to anticipate all claimed features in claim 1.

In regards to independent claims 20 and 29, the Applicant would like to point out that the Office Action has failed to address every single features in claims 20 and 29. More specifically, claims 20 and 29 recites “information stored within the computer-readable medium includes ... requested service shop data....” The Office Action does not address this feature. In addition, McIntyre’s does not define ID as requested service shop data. Applicant believes that the rejection to independent claims 20 and 29 based on McIntyre is improper.

Therefore, for at least these reasons, independent claims 1, 20, and 29 are distinguishable from McIntyre. Claims 2, 7-9, and 25 depend from claims 1 and 20, directly or independently. Therefore, for at least the reasons stated with respect to claims 1 and 20, claims 2, 7-9, and 25 are also distinguishable from McIntyre.

Accordingly, Applicant respectfully requests that the rejection of claims 1, 2, 7-9, 20, 25, and 29, based on McIntyre, be withdrawn.

35 U.S.C. § 103 REJECTION – MCINTYRE IN VIEW OF HURTADO ET AL.

Claims 10, 11, 13, 14, 16, 17, 19, 26-28, and 33-35 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over McIntyre in view of Hurtado et al. (USPN 6,611,812) (hereinafter “Hurtado”). Applicant respectfully traverses.

For a Section 103 rejection to be proper, a *prima facie* case of obviousness must be established. *See M.P.E.P. 2142*. One requirement to establish *prima facie case* of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. *See M.P.E.P. 2142; M.P.E.P. 706.02(j)*. Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, neither McIntyre nor Hurtado or in combination thereof, teach or suggest all claimed features in claim 10. For instance, claim 10 recites “A computer-readable medium ... *wherein the print-order acceptor information designates an acceptor as a print-order destination, and command data to be sent to a receiver....*” As stated above, McIntyre fails to

teach or suggest “*print-order acceptor information designates an acceptor as a print-order destination, and command data to be sent to a receiver.*”

In addition, Hurtado teaches an automated run program. However, Hurtado fails to teach or suggest “*print-order acceptor information designates an acceptor as a print-order destination, and command data to be sent to a receiver.*”

Therefore, for at least these reasons, claims 10 and 16 are distinguishable from the combination of McIntyre and Hurtado. Claims 11, 13, 14, 17, 19, 26-28, and 33-35 depends from claims 1, 10, 16, 20, and 29. Therefore, for at least the reasons stated with respect to claim 1, claim 3 is also distinguishable over the combination of McIntyre and Hurtado.

Applicant respectfully requests that the rejection of claims 10, 11, 13, 14, 16, 17, 19, 26-28, and 33-35, based on McIntyre and Hurtado, be withdrawn.

35 U.S.C. § 103 REJECTION – MCINTYRE FURTHER IN VIEW OF NAKAJIMA ET AL.

Claims 36, 39, and 40 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over McIntyre further in view of Nakakima et al. (USPN 6,665,083) (hereinafter “Nakajima”). Applicant respectfully traverses.

As presented above, McIntyre fails to teach or suggest “*print-order acceptor information which designates an acceptor as a print-order destination.*” Moreover, McIntyre fails to teach or suggest “*print-order acceptor information designates an acceptor as a print-order destination, and command data to be sent to a receiver.*” In addition, Nakakima fails to teach or suggest the above limitation to supplement McIntyre’s missing feature.

As set forth on page 11 of the Office Action, the Examiner relies on Nakakima as allegedly pertaining to incremental features of the above listed dependent claims. The Examiner’s reliance on Nakakima, however, fails to make up for the deficiencies of McIntyre discussed above with respect to Claims 1, 20, and 29. Therefore, the asserted combination of McIntyre and Nakakima (assuming these references may be combined, which applicant does not admit) fails to establish prima facie obviousness of any pending claims.

35 U.S.C. § 103 REJECTION – MCINTYRE AND HURTADO FURTHER IN VIEW OF
NAKAJIMA

Claims 37 and 38 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over McIntyre and Hurtado further in view of Nakakima. Applicant respectfully traverses.

As presented above, McIntyre and Hurtado fails to teach or suggest “*print-order acceptor information designates an acceptor as a print-order destination, and command data to be sent to a receiver.*” In addition, Nakakima fails to teach or suggest the above limitation to supplement McIntyre and Hurtado’s missing feature.

As set forth on page 12 of the Office Action, the Examiner relies on Nakakima as allegedly pertaining to incremental features of the above listed dependent claims. The Examiner’s reliance on Nakakima, however, fails to make up for the deficiencies of McIntyre and Hurtado discussed above with respect to Claims 10 and 16. Therefore, the asserted combination of McIntyre, Hurtado, and Nakakima (assuming these references may be combined, which applicant does not admit) fails to establish prima facie obviousness of any pending claims.

Conclusion

In view of the above remarks, it is believed that claims are allowable.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact D. Richard Anderson Reg. No. 40,439 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: September 6, 2007

Respectfully submitted,

By 

D. Richard Anderson

Registration No.: 40,439

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant